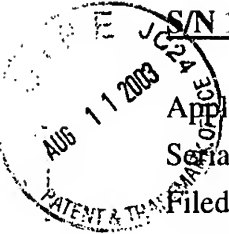


5
Election

PATENT

Cofor
8-26-03



S/N 10/032032

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jay Dee Krull et al.

Examiner: Richard M. Camby

Serial No.: 10/032032

Group Art Unit: 3661

Filed: December 21, 2001

Docket: 1528.024US1

Title: PERSONAL DIGITAL ASSISTANT WITH MAP TO ADDRESS
BOOK/ADDRESS BOOK TO MAP FUNCTIONALITY

RESPONSE TO RESTRICTION REQUIREMENT

RECEIVED
AUG 14 2003
GROUP 3600

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Applicant has reviewed the Restriction Requirement mailed July 8, 2003. The Restriction Requirement stated:

This application contains claims directed to the following patentably distinct species of the claimed invention: Figures 1a-c, Figure 9 and Figure 10 with any one of the sub species of Figures 2-8 and 11-26 that define a single operative device that is disclosed as usable together.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if not generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant's below-named representative requested and was granted a telephone interview with Examiner Camby on August 4, 2003 to request clarification of the Restriction Requirement. The Examiner clarified that species / sub species language is intended to require the Applicant to elect one of at least sixty-nine (69) patentably distinct species (FIGs. 1 and 2; FIGs. 1 and 3 . . . FIGs. 1 and 26; FIGs. 9 and 2; FIGs. 9 and 3 . . . FIGs. 9 and 26; FIGs. 10 and 2, FIGs. 10 and 3 . . . FIGs. 10 and 26).

Applicant provisionally elects, with traverse, the species of FIG. 1 and the subspecies of FIG. 7. FIGS. 1A-1C show front, side and top views of a PDA with an integrated GPS receiver, and FIG. 7 is a representation of a PDA architecture that includes PDA and GPS applications. Applicant respectfully submits that all of the claims read on the elected species / sub species. The methods recited in claims 1-13 are performed using the PDA, the PDA uses the computer-readable executable instructions recited in claims 14-22 and the data structure recited in claims

23-27, and claims 28-38 recite a PDA.

Applicant respectfully traverses the assertion that no claims are generic to the identified species and sub-species, and further traverses the Restriction Requirement for the following reasons:

- The Restriction Requirement is unclear, and fails to mention the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species, as required by MPEP §814 under the subtitle SPECIES, and as required by MPEP §809.02(a).
- The claims are not mutually exclusive. MPEP §806.04(f) states that claims to be restricted to a different species must be mutually exclusive.
- The specification discloses a relationship between the species and sub-species (*i.e.* between the figures in the application).
- Applicant notes that the term “one embodiment” and variations thereof in the specification do not necessarily indicate an embodiment mutually exclusive of all other embodiments. Applicant respectfully asserts that the figures are not mutually exclusive, but can be combined as an embodiment.

RESPONSE TO RESTRICTION REQUIREMENT

Serial Number: 10/032032

Filing Date: December 21, 2001

Title: PERSONAL DIGITAL ASSISTANT WITH MAP TO ADDRESS BOOK/ADDRESS BOOK TO MAP FUNCTIONALITY

Page 3

Dkt: 1528.024US1

Applicant respectfully urges the Examiner to reconsider and withdraw the Restriction Requirement in view of Applicant's argument. Applicant respectfully requests a favorable examination of the merits of this patent application. The Examiner is invited to telephone Applicant's attorney (612-373-6960) to facilitate prosecution of this application. Please charge any additional fees deemed necessary to Deposit Account 19-0743.

Respectfully submitted,

JAY DEE KRULL ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6960

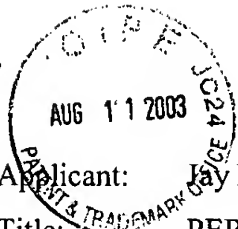
Date 8-8-03 By Marvin L Beekman
Marvin L Beekman
Reg. No. 38,377

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8th day of August, 2003.

Name

Signature

3661



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jay Dee Krull et al.

Title: PERSONAL DIGITAL ASSISTANT WITH MAP TO ADDRESS BOOK/ADDRESS BOOK
TO MAP FUNTIONALITY

Docket No.: 1528.024US1

Filed: December 21, 2001

Examiner: Unknown

Serial No.: 10/032032

Due Date: August 8, 2003

Group Art Unit: 3661

MS Non-Fee Amendment

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

RECEIVED
AUG 14 2003
GROUP 3661

We are transmitting herewith the following attached items (as indicated with an "X"):

☒ A return postcard.

☒ An Response to Restriction Requirement (3 Pages).

If not provided for in a separate paper filed herewith, Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938, Minneapolis, MN 55402 (612-373-6900)

By: Mar L B

Atty: Marvin L. Beekman

Reg. No. 38,377

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 8th day of August, 2003.

Patricia A. Altman
Name

Marvin L. Beekman
Signature

Customer Number 21186

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938, Minneapolis, MN 55402 (612-373-6900)

(GENERAL)